

REMARKS

Claims 1, 4, 5, 7, 10, 12, 17, 19-24, 26, 35, 36, and 38 were rejected and remain pending. In addition, claims 1, 10, 12, 17, and 38 have been amended herein to recite a tissue-specific promoter. Applicants' specification fully supports these amendments. For example, original claim 1 recited that the promoter can be a tissue-specific or pathogen-specific promoter. Thus, no new matter has been added.

In light of these amendments and the following remarks, Applicants respectfully request reconsideration and allowance of claims 1, 4, 5, 7, 10, 12, 17, 19-24, 26, 35, 36, and 38.

Information Disclosure Statement

Applicants respectfully note that an initialed copy of the PTO-1449 form filed November 1, 2002 has not been returned. Thus, Applicants respectfully request return of an initialed copy. For the Examiner's convenience, a copy of the PTO-1449 form filed November 1, 2002 is attached hereto. In addition, copies of the listed references can be resubmitted upon request.

Double Patenting Rejections

The Examiner rejected claims 1, 4, 5, 7, 10, 12, 19, 22-24, 26, 35, 36, and 38 under the judicially created doctrine of obviousness-type double patenting over claims 1-7 of U.S. Patent No. 6,271,359. Applicants respectfully disagree. To further prosecution, however, a terminal disclaimer has been filed herewith obviating the obviousness-type double patenting rejections.

Rejections under 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 1, 7, 10, 12, 17, 19-24, 26, 35, 36, and 38 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner stated that any negative limitation or exclusionary proviso must have basis in the original disclosure. In addition, the Examiner stated that claiming the recombinant nucleic acid "merely by defining what it is not, and by providing a function of the nucleic acid is not sufficient to clearly define the invention"

Applicants respectfully disagree. Applicants' specification provides adequate basis for the previously presented proviso. To further prosecution, however, claims 1, 10, 12, 17, and 38 have been amended herein to replace the previously presented proviso with the recitation of a tissue-specific promoter.

In addition, the present claims are fully described and clearly defined. For example, claim 1 recites the structure of the recited autocatalytically cleaving ribozyme as including a first arm of complementary sequence and a second arm of complementary sequence. Claim 1 also recites the location of the recited cleavage site. In addition, claim 1 recites that one of the arms is proximal to the trans-acting ribozyme and that the other is longer than the corresponding arm of a pCLIP cassette. A person having ordinary skill in the art reading Applicants' specification would have appreciated that the present claims are adequately described.

Applicants note that the context of the quote from MPEP § 2163 on page 5 of the Examiner's Official Action does not support this rejection. The quote refers to a biomolecule sequence described "only by a functional characteristic." (Emphasis added). In addition, the preceding topic sentence states that the "claimed invention as a whole may not be adequately described where an invention is described solely in terms of a method of its making coupled with its function and there is no described or art-recognized correlation or relationship between the structure of the invention and its function." (Emphasis added). As demonstrated above, the presently claimed invention is not solely described in terms of a method for making it coupled to its function. In fact, the present claims recite multiple structural attributes of the present invention, and a person having ordinary skill in the art would have appreciated that the present claims are fully described. Thus, the present claims satisfy the written description requirements.

In light of the above, Applicants respectfully request withdrawal of the rejections of claims 1, 7, 10, 12, 17, 19-24, 26, 35, 36, and 38 under 35 U.S.C. § 112, first paragraph.

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CONCLUSION

Applicants submit that claims 1, 4, 5, 7, 10, 12, 17, 19-24, 26, 35, 36, and 38 are in condition for allowance, which action is requested. The Examiner is invited to call the undersigned attorney at the telephone number below if such will advance prosecution of this application. The Commissioner is authorized to charge any fees or credit any overpayments to Deposit Account No. 06-1050.

Respectfully submitted,

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